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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,798	08/22/2001	Denis Faucher	15309-IUS CC/MG	7972
20988	7590	08/05/2004	EXAMINER	
OGILVY RENAULT 1981 MCGILL COLLEGE AVENUE SUITE 1600 MONTREAL, QC H3A2Y3 CANADA			RUDDOCK, ULA CORINNA	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/933,798

Applicant(s)

FAUCHER, DENIS

Examiner

Ula C Ruddock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendment and accompanying remarks filed May 7, 2004. In view of Applicant's amendment, the Examiner withdraws the previously set forth rejection in view of Yamamoto (US 4,357,377) as detailed in the office action dated July 16, 2003. Despite this advance, the invention as currently claimed is not found to be patentable for reasons herein below.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 7, 2004, has been entered.

#### ***Claim Objections***

3. Claims 1, 3, 6, and 7 are objected to because of the following informalities: in claims 1, 3, and 6, Applicant discloses a "non transudent" material. This term is objected to because it is not in the dictionary, as seen in the attached copy of page 1256 of *Merriam Webster's Collegiate Dictionary*, 10<sup>th</sup> Edition. Also, in claim 6, Applicant discloses a "polybutyrene" material. It appears as though Applicant meant to say "polybutene" since there is no such composition as polybutyrene. Furthermore, in claim 7, Applicant discloses that the "support sheet is composed fiber." It appears as though a word is missing from the claim. Appropriate correction is required.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/338857. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United

States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Heifetz (US 2003/0054127). Heifetz discloses a sealing sheet assembly bondable to a construction surface (abstract). The assembly comprises an upper layer that is water and gas impermeable [0094]. The upper layer may be made of polymer modified bitumen, wherein the polymer comprises styrene-butadiene-styrene. The thickness of the bitumen layer is between 3-6 millimeters [0094]. The polymer modified bitumen may be covered with a metallic film [0095]. It should be noted that the Examiner is equating Heifetz' metallic film to the impervious surfacing material of the present invention. The bitumen layer of Heifetz also includes a reinforcing structure such as woven and non-woven cloths which serves for raising the tensile, breaking, and tear resistance strengths of the bitumen layer [0115]. It should be further noted that the Examiner is equating Heifetz' reinforcing structure to Applicant's support sheet. With regard to claim 2, it is the Examiner's position that the adhesive material is not being positively claimed and thus, does not constitute a patentable limitation. The assembly further contains protective fillers [226].

8. Claims 1-7, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0315239 (EP '239). EP '239 discloses a water proofing bituminous composition. Waterproofing sheaths are disclosed which contain the bituminous composition in association with a reinforcement (abstract). The bitumen composition is modified with ethylene polymer, wherein the composition contains from 20-25 parts by weight of ethylene polymer per each 100 parts by weight of bitumen (page 2, ln 41-44). Therefore, with regard to claim 10, the composition contains up to 23.1% of ethylene and 76.9% of bitumen. With regard to claim 2, , it is the Examiner's position that

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the adhesive material is not being positively claimed and thus, does not constitute a patentable limitation. The material has a thickness of 2-6 millimeters (page 3, ln 13-14). The waterproofing sheaths contains a support material selected from non-woven polyester fabrics and fiberglass web (page 3, ln 11-13). The sheaths can be provided with a surface coating of a metal sheet, such as a sheet of aluminum or of copper for protective purposes (page 3, ln 20-21). It should be noted that the Examiner is equating the metal sheet of EP '239 to the impervious surfacing material of the present invention. The composition further contains filler materials (page 3, ln 8-9).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0315239 (EP '239), as shown above. EP '239 discloses the claimed invention except for the teaching that the composition contains up to 40% filler. It should be noted that the amount of filler in a bituminous composition is a result effective variable. For example, the greater the amount of filler present in the composition directly affects the processability of the composition. Therefore, it would have been obvious to have used a composition containing up to 40% filler, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have

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optimized the filler amount motivated by the desire to create a composition with excellent processability.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR

*UCR*

*Ula Ruddock*

**Ula C. Ruddock**  
Primary Examiner  
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